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In re Application of :
LI *et al* :
U.S. Application No.: 10/528,765 :
PCT No.: PCT/EP2003/010410 :
Int. Filing Date: 18 September 2003 :
Priority Date: 25 September 2002 :
Attorney Docket No.: 0WSAG0107PUSA :
For: TWO-LAYER LTO TEMPERATURE :
OXIDE BACKSIDE SEAL FOR A :
WAFER :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a)" filed 19 January 2006.

BACKGROUND

On 17 October 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 19 January 2006, applicants filed the subject petition which was accompanied by, *inter alia*, exhibits A - D and the \$130.00 surcharge fee.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Petitioners submitted a \$130.00 petition fee on 14 December 2004. The \$70.00 difference will be charged to Deposit Account No. 02-3978 as authorized.

With regards to item (3), the last known address of Jin-Xing Li is listed as:

BLK 722,
#02-123
Singapore, 510722

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two named inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicant submitted evidence that they attempted to locate the nonsigning inventor by contacting the former employer of Mr. Li. However, this evidence alone is insufficient to show that a "diligent effort" was made to locate the nonsigning inventor. In addition, petitioner has not provided the required statement of facts (by the person having firsthand knowledge) outlining the steps taken to locate the whereabouts of the nonsigning inventor. Moreover, there was no evidence that a search of phone or internet records was even attempted to locate Mr. Li.

For these reason, item (2) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302